

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Yuji OHASHI et al.

Examiner: unknown

Serial No.: 10/527,078

Group Art Unit: 1617

Filed: March 9, 2005

Title: WHITENING AGENT CONTAINING CRYSTALLINE MOLECULAR
COMPLEX OF HYDROQUINONE AND SURFACTANT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the requirement for restriction dated December 28, 2007, Applicants hereby elect Group I, claims 1-6, drawn to the whitening agent. Moreover, with respect to the election of species, Applicants hereby elect hydroquinone and, as the surfactant, STAC. Both the requirement for restriction and the requirement for election are respectfully traversed. Before discussing the merits of that traversal, it is noted that claims 1-5 read upon the elected species.

The requirement for restriction is respectfully traversed, inasmuch as it is submitted to violate PCT rule 13.1, as embodied in 37 C.F.R. 1.475. The restriction is based, as discussed in the paragraph bridging pages 2 and 3 of the Office Action, on the allegation that groups I – V are divisible as they lack a “special technical feature” patentable over the art. However, it is submitted that the categories of these claims are defined, by relevant legal rule, to contain the same special technical feature. Group I contains claims to a product. Group II contains claims to the use of that product. Group III contains additional claims to the use of the product, and Group IV contains

claims to the production of the product. 37 C.F.R. 1.475, writing into statute PCT rule 13.1, states that a national stage application “will be considered to have unity of invention” if the claims are drawn to categories including “(3) a product, a process specially adapted for the manufacture of the said product, and a use of the product.” Accordingly, it is submitted that separation of the production of the product, and use of the product, from the product itself violates the rule. Withdrawal of the restriction requirement is therefore appropriate, and respectfully requested.

With respect to the election of species, it is submitted that the present claims are “Markush” claims, in that they recite alternative species of hydroquinone and surfactant. In such a situation where Markush claims are involved, MPEP §1850 states that the requirement of a technical interrelationship and same or corresponding special technical feature is met or the alternatives are of a similar nature. The MPEP continues that, for alternatives of chemical compounds, the requirement of “similar nature” is met where all alternatives have a common property or activity, and either a common structure or all belong to a recognized class of chemical compounds in the art to which the invention pertains. It is submitted that both of these requirements are met, in as much as hydroquinone and its derivatives are all based on the hydroquinone structure, and the surfactants all are a recognized class of materials. Accordingly, it is submitted that the requirement for election should also be withdrawn.

Withdrawal of the requirement for election and restriction is respectfully requested, and a prompt action on the merits is requested.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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